

## **REMARKS**

### **Response to Notice of Non-Compliant Amendment**

Applicant received a Notice of Non-Compliant Amendment, mailed July 15, 2004, indicating the above-referenced patent application was filed with 33 claims and only 29 claims were included with the Response to Office Action, filed June 11, 2004. Applicant's file copy was not a copy of the instant application as filed. Applicant obtained a Certified Copy of the instant application and apologizes for any confusion.

The claims omitted from the earlier Response, filed June 11, 2004, are originally filed claims 7, 14, 21 and 33, which are identical claims depending from originally filed independent claims 1, 8, 15, and 26 and limiting the other item(s) to a food item, a toy or a newspaper. Originally filed claim 14 is canceled. This Supplemental Response differs from the earlier filed Response in the inclusion of these claims in the Amendment to the Claims section and in the numbering of the claims and of the pages cited by Applicant in support of the claim amendments and arguments presented herein.

As discussed with the Examiner during a telephone conversation on August 4, 2004, with the exception of the status of the claims which identifies claims correctly, Applicant will include corrected claim numbers in italics parenthetically after the incorrect claim number. For citations from the application, incorrect page/line numbers will be deleted and replaced with corrected page/line numbers in italics. Sentences appearing in italics are supplemental to the earlier response. The numbering of claims 1-6 is unchanged.

### **Status of the claims**

Claim 1-33 are pending. Claims 1-33 are rejected. Claims 6, 9-14, 20, 23-25, 28-29, and 31 are canceled. Claims 1-5, 7-8, 15-19, 21-22, 26-27, 30, and 32-33 are amended. New claims 34-35 are added. No new matter is added.

### **Amendments to the claims**

Claims 1, 13 and 23 (1, 15 and 26) are amended to overcome the 35 U.S.C. §103(b) rejection, as discussed *infra*. Claim 1 is amended to recite additional limitations of

the kiosk, such as a touch screen panel having an audio, a visual or an audiovisual display of food or other items (*pg. 13, ll. 19 to pg. 14, ll. 15*), an audio transmission means, a PIN pad and a printer (*pg. 13, ll. 10-17; Fig. 4*). Claim 1 also is amended to recite that the payment instruments are either credit or debit instruments (*pg. 15, ll. 2-5*) and to include a step of entering a PIN for a cash back transaction using a debit card whereupon the amount of cash back desired is debited from the patron's account with the total of the food order should the patron wish for cash back (*pg. 15, ll. 5-6*). Claim 7 (8) is amended to depend from amended claim 1 and to limit the method by adding the step of suggesting to the patron additional items for purchase that originally was step (c) in claim 7. New claim 30 (34) is added to limit the method by adding the step of receiving an electronic signature from the patron at the kiosk.

Claim 13 (15) is amended as is claim 1. Additionally, claim 13 (15) is amended to include the limitation of a voice recognition means in the kiosk (*pg. 16, ll. 21 to pg. 17, ll. 6*). Claim 19 (22) is amended to depend from amended claim 13 (15) and to limit the method by adding the step of receiving an electronic signature at the kiosk from which originally was step (f) in claim 19 (22). New claim 31 (35) is added to limit the method by adding the step of suggesting to the patron additional items for purchase.

Claim 23 (26) is amended as a self-service ordering system using electronic payment. Claim 23 (26) also is amended to include the limitation where the touch screen panel has an audio, a visual or an audiovisual display of food or other items (*pg. 13, ll. 19 to pg. 14, ll. 15*). Claim 23 (26) is amended to include the additional limitations of a means for receiving and verifying a PIN, means for obtaining cash back and a printer (*pg. 13, ll. 10-17; Fig. 4*). Claim 27 (30) is amended to limit the self-ordering system to comprising means for receiving electronic signature "at the kiosk".

Claims 2, 14 and 24 (2, 16 and 27) are amended to remove Markush language and to define the specific payment instruments as credit or debit instruments. Claims 3 and 15 (3 and 17) are amended to recite "displaying" advertisements as active method steps. Claims 4 and 16 (4 and 18) are amended to limit the method step to printing out a receipt containing the total charge. Claims 5 and 17 (5 and 19) are amended to limit the method step to printing a coupon on the printed receipt. *Claims 7, 21 and 33*

*are amended to limit the other item(s) to a toy or newspaper.* No new matter has been added in any claim amendment or newly added claim.

### Claim objections

The Examiner states that claim 8 is objected to because in line 11 of the claim “a mean selected” is incorrect. *Applicant has amended claim 8 to delete the Markush language including the incorrect term “a mean selected”.*

### The 35 U.S.C. §103(a) rejection

Claims 1-29 (1-33) are rejected under 35 U.S.C. §103(a) as being unpatentable over **Lucero** (RE 34,872), in view of **Mueller et al** (U.S. Patent No. 5,235,509). This rejection is respectfully traversed.

The Examiner states that **Lucero** discloses a method of self-service ordering at a restaurant comprising (1) providing a kiosk at a drive-thru location which has a push button panel and a means for receiving a credit card; (2) operating panel by patron to order; (3) totaling charges; (4) inserting credit card into receiving means; (5) verifying the credit card account; (6) debiting the credit card account; (7) assembling the item at a second location; (8) delivering the item to the patron at a location remote from kiosk; and printing out a receipt. The Examiner also states that, although not taught by **Lucero** or **Mueller et al.**, it is common in the art to print a location on a receipt, to print a coupon on a receipt, use voice recognition software and to receive an electronic signature

The Examiner states that **Mueller et al.** discloses a restaurant kiosk with a touch screen for taking orders; displaying advertisements on the touch screen and suggesting additional items via a video display. The Examiner further states that although not taught in **Lucero** or **Mueller et al.**, it is common in the art to print a location on a receipt and to print coupons on a receipt.

Thus, the Examiner states it would be obvious to combine the teachings of **Mueller et al.** and of what is common in the art with **Lucero** by 1) substituting the touch screen in **Mueller** for the push button panel in **Lucero** as they are more easily updated; 2) adding advertisements to the touch screen to promote products; 3) suggesting additional

items on the touch screen to promote sales; 4) printing the location where the order is to be picked up on the receipt of **Lucero** to increase throughput; and 5) printing coupons on the receipt of **Lucero** to promote products and provide incentive for customers to return.

**Mueller et al.** is as the Examiner states. **Lucero** discloses a drive through order entry system for a fast food restaurant in which menu items are displayed along with the cost. The patron inserts a credit card into a slot for reading the card to make an electronic payment at the order station where it is held to verify the status of the account (col. 6, ll. 64 to col. 7, ll. 6). When the card is approved, the patron is prompted to then begin ordering (col. 7, ll. 6-9). The patron pushes buttons to select items to purchase (col. 2, ll. 58-65). Once the order is placed, the account is debited, an imprinted credit voucher and a receipt are printed and the card is returned to the patron (col. 8, ll. 1-17). The patron proceeds to a pickup station to sign and present the credit voucher in the presence of an attendant in exchange for the ordered food (col. 8, ll. 18-22).

Applicant's invention as amended in claims 1 and 23 (1 and 26) recites a method of using a kiosk placed at a fast food restaurant where the patron first selects food items on a touch screen panel and places the order, then inserts a credit or debit instrument for electronic payment which is approved and the account debited. The patron picks up the prepared food at a location distant from the kiosk. The patron may or may not request a receipt be printed. The patron may also request cash back from a debit transaction using a PIN pad for receiving and verifying a PIN. The kiosk in amended claim 23 (26) thus has means for receiving and verifying a personal identification number and for obtaining cash back from the debit payment instrument.

Applicant's method uses instant approval of either credit or debit electronic payment instruments and debit of account. Thus, in using Applicant's self-service ordering system, a patron can place an order and provide a payment instrument for instant approval and account debiting and proceed to pick up the order. Therefore, a faster and more efficient system is provided. In contrast the system in **Lucero** lacks the capability to instantly approve the electronic payment and debit the customer's account. The patron in **Lucero** cannot even select items to order until the account is approved.

Additionally, **Lucero** does not teach or suggest cash back transactions after electronic payment nor a system incorporating means to accomplish this.

In determining obviousness, the combination of the prior art and/or what is known in the art at the time of the invention must teach all the claim elements of the rejected invention. Combining **Lucero** with **Mueller et al.** does not meet this standard. The suggestion and motivation for one of ordinary skill in the art found in this combination is to use the touch screen taught in **Mueller et al.** instead of the push button screen taught in **Lucero**. However, this is not applicants' invention.

Amended claim 13 (15) recites the basic method of self-service fast food ordering as recited in amended claim 1 with the exception that the patron uses a voice recognition feature to verbally order food items displayed on the touch screen panel. The Examiner states that voice recognition software is common in the art. Applicant submits that although voice recognition software existed at the time of the instant invention, it was not commonly used and was used primarily for telephone-directory assistance inquiries or placing orders over the telephone. To use the system one had to "call it up". An electronic voice prompts the user for appropriate verbal input and generally repeats the input back to the user for accuracy.

The fast food industry has traditionally required ordering to be a verbal interaction between an employee and a patron, either face to face or through a speaker at a drive-through. A fast food restaurant can have a high level of interfering ambient sound or conversation. In the voice recognition systems used at the time of the instant invention, the telephone provided a better environment in which to recognize a customer's articulated commands.

Thus, one of ordinary skill in the art would not find that the voice recognition was commonly used at the time of the instant invention nor be motivated to use voice recognition with an electronic voice prompt as a means of ordering in a fast food environment with a reasonable expectation of success, absent a teaching or suggestion to display the verbal input or prompting questions on the screen as feedback without touching the screen to induce such display. This teaching is found in Applicant's specification (pg. 16, ll. 21 to pg. 17, ll. 6) and cannot be used to determine obviousness.

However, even should one of skill in the art find a suggestion or motivation to use voice recognition as a means of ordering fast food, the combination of this, **Lucero** and **Mueller et al.** still does not yield Applicant's invention for the reasons discussed *supra*.

*Claims 2-5 and 7-8, 16-19 and 21-22 and 27, 29 and 33* depend directly or indirectly from amended independent claims 1, 13 and 23 (1, 15 and 26). *Dependent claims 2-5 and 8 and 16-19 and 22* further limit the credit or debit payment instruments and limit the method with additional steps of displaying and/or suggesting additional items, printing a receipt and/or a coupon thereon, or obtaining an electronic signature. Dependent claims 24 (27) and 27 (29) limit the self-ordering system by means of obtaining an electronic signature and means of receiving and responding to an articulated and verbalized order. *Dependent claims 7, 21 and 33 limit the other items ordered or offered to a toy or to a newspaper.* Thus, if the combination of **Lucero** with **Mueller et al.** and with what is standard in the art does not render amended claims 1, 13 and 23 (1, 15 and 26) obvious, neither will the incorporation of any of these dependent claims render claims 1, 13 and 23 (1, 15 and 26) obvious.

Furthermore, Applicant submits that it is known in the fast food industry that kiosks installed in well-established fast food outlets over the past ten years have failed. In the early 1990's Taco Bell placed multiple kiosks, where all transactions were completed at the front counter registers, in each of 20 stores in a pilot program throughout the U.S. The units were pulled within two years of installation and never redeployed. A Burger King franchise in Loveland, CO installed kiosks in the early 1990s and removed them within 2 years. Arby's also tried installing kiosks and subsequently pulled them without any replacement. All of these kiosks required a cash transaction.

McDonald's Corporation also has tested kiosks for the last ten years. Again these were set up for cash only transactions. All of these initial locations subsequently were removed within two years of installation. However, since the time of the instant invention, McDonald's Corporation has placed Applicant's kiosks at over 50 McDonald's locations and are using them successfully.

Thus, at a minimum, absent the teaching or suggestion of the claim limitations discussed *supra* in the combination of **Lucero** with **Mueller et al.** and/or what

is known in the art, the invention as a whole was not obvious to one of ordinary skill in the art at the time the invention was made. Additionally, the use of Applicant's kiosks in a significant number of McDonald's demonstrates success over the failure of prior art kiosks placed in well known fast food establishments, including McDonald's. Accordingly, in view of the amendments and arguments presented herein, Applicants respectfully request that the rejection of claims 1-29 (1-33) under U.S.C. 103(a) be withdrawn.

This is intended to supplement the Response, filed June 11, 2004, to the Office Action mailed December 11, 2003. Please debit any additional applicable fees from Deposit Account No. 07-1185. If any issues remain outstanding, the Examiner is respectfully requested to telephone the attorney of record identified *supra* for immediate resolution.

Respectfully submitted,

DATE: 8/5/04



Benjamin Aaron Adler, Ph.D., J.D.  
Registration No. 35,423  
Counsel for Applicant

ADLER & ASSOCIATES  
8011 Candle Lane  
Houston, Texas 77071  
(713) 270-5391  
[badler1@houston.rr.com](mailto:badler1@houston.rr.com)